REMARKS

Applicants note that a Petition pursuant to 37 C.F.R. § 1.181, in response to a USPTO Communication dated July 18, 2003, was filed on August 8, 2003. The Petition concludes that a Reply under 37 C.F.R. § 1.111 filed June 23, 2003, was not fully responsive to the prior Office Action. The Petition contained Applicants' remarks that the Reply of June 23rd was fully responsive to the prior Office Action.

Thereafter, Applicants have corresponded with Examiner Nathan Nutter regarding the present application, wherein this interview took place on August 20, 2003. Applicants thank the Examiner for his time. In response, Applicants submit these supplemental remarks, which are similar to those remarks in the mentioned Petition.

Background Facts

A Restriction Requirement issued on January 29, 2003 (copy enclosed), which restricted the original claims of the present application into four categories under 35 U.S.C. § 121, including Group I constituting claims 1-9 directed to a "method of preparing a low allergic (*sic*) natural rubber latex"; and Group III constituting claims 18-21 directed to a "low allergic (*sic*) natural rubber". Subsequently, Applicants filed a Reply to Restriction Requirement on February 24, 2003 (copy enclosed), which elected the claims of Group III (claims 18-

21) with traverse. Thereafter, an Office Action issued on March 21, 2003, which included rejections of elected claims 18-21 based on 35 U.S.C. §§ 112, second paragraph and 102(b). Subsequently, Applicants filed an Amendment and Reply Under 37 C.F.R. § 1.111 on June 23, 2003 (copy enclosed), which included a substantive change to claim 18 and minor formal changes to claims 19-21. Original claim 18 recited "A low allergic natural rubber obtained by a decomposition treatment of a protein...", whereas amended claim 18 further defined the "decomposition treatment" feature by specifying how this treatment was carried out by adding a protease and aging.

Subsequently, the USPTO Communication of July 18, 2003, issued stating in relevant part that,

> The reply filed on 23 June 2003 is not fully responsive to the prior Office Action because: the amendment to claims 18-21, the elected invention, places the invention into a separate grouping, i.e. Group I, which is drawn to a patentably distinct concept from that originally claimed.

Summary of Reasons that USPTO Communication Is Incorrect

The USPTO Communication of July 18th is incorrect in concluding that the Reply of June 23rd is not fully responsive, since the changes made to elected claims 18-21 in the Reply of June 23rd did not cause these claims to be placed in a separate patentably distinct category, *i.e.*, the method claims 1-9 of Group I. Rather, claims 18-21 in the form amended in the Reply of June 23rd still remain in the original category of Group III. The product-by-process claims 18-21 remain as proper product-by-process claims completely consistent within the

originally defined category of Group III based on original product-by-process claims 18-21. The USPTO Communication incorrectly concludes that amended claims 18-21 have been converted into method-of-making claims, which correspond to original claims 1-9. This conclusion is simply incorrect.

Detailed Reasons Supporting Applicants' Position

The USPTO Communication concludes that claims 18-21 amended in the Reply of June 23rd should now be placed into the category of Group I, presumably along with claims 1-9, wherein this category is described as a "method of preparing [a product]". However, amended claims 18-21 clearly should remain in the originally specified category of Group III, which was clearly described as a category including claims directed to a certain "product", as compared to a "method" (Group I). A review of the original and amended forms of claims 18-21 clearly reveals that in both forms these claims are product-by-process claims which, by the way, are completely appropriate under M.P.E.P. § 2113, since the structure of the claimed natural rubber can only be defined by the decomposition treatment process steps disclosed in the present application.

Applicants respectfully submit that the USPTO Communication is incorrect in concluding that the changes to claims 18-21 have converted these claims into "method" claims. Claims 18-21 remain product or

product-by-process claims consistent with the claims of Group III defined in the Restriction Requirement.

In view of the above, it is respectfully submitted that the USPTO Communication has failed to identify any correct basis for concluding that the Reply of June 23rd was not fully responsive to the Office Action of March 21st. Consequently, Applicants respectfully request the Examiner to confirm that the Reply of June 23rd was indeed fully responsive to the prior Office Action of March 21, 2003, such that the Patent Examiner should now be required to act on and appropriately respond to the Reply of June 23rd.

Conclusion

Applicants respectfully submit that the Reply of June 23rd is fully responsive to the prior Office Action so as to require the Examiner to enter and fully consider this Reply.

If any questions arise regarding the above matters, please contact Applicants' representative, Andrew D. Meikle, in the Washington metropolitan area at the phone number listed below.

Applicants respectfully submit that no fees for extensions of time are necessary since the previous June 23rd Reply was fully responsive to the outstanding Office Action. If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

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Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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